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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/066,943

02/04/2002

Ralf Wiedemann

10660-62US (10936P6
US)

4310

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10/09/2003

AKIN GUMP STRAUSS HAUER & FELD L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103-7013

EXAMINER

FONTAINE, MONICA A

ART UNIT

PAPER NUMBER

1732

DATE MAILED: 10/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/066,943

Applicant(s)

WIEDEMANN ET AL.

Examiner

Monica A Fontaine

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

This office action is in response to the Amendment filed 23 July 2003.

The following objections have been overcome:

A. Minor Informalities: Abstract and Title

The following rejections have been withdrawn:

A. 35 USC 103(a) over Saeki et al. (U.S. Patent 4,946,633), hereafter "Saeki", in view of the instant specification: Claims 1-2, and 4-6

B. 35 USC 103(a) over Saeki and the instant specification, in further view of Okumoto et al. (U.S. Patent 5,009,425), hereafter "Okumoto,"; Claim 3

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, and 5-7 rejected under 35 U.S.C. 103(a) as being unpatentable over Ono et al. (U.S. Patent 5,316,712), in view of Kacher et al. (U.S. Patent 5,496,488). Regarding Claim 1, Ono et al., hereafter "Ono," show that it is known to carry out a method of producing a plurality of moldings in one mold (Figure 1A), comprising providing a mold which has a plurality of cavities having a shape corresponding to the moldings (Figure 1A), the cavities being arranged in the mold in such a way that, except for cavities in an end or peripheral position of the mold, each

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of the cavities is linked to at least two closely adjacent cavities (Figures 4 and 6), providing a fluid casting compound of a material (Column 6, lines 43-64), introducing the fluid casting compound into the mold at at least one point such that all of the cavities become essentially completely filled with the casting compound (Column 3, lines 35-37), solidifying the casting compound to produce moldings (Column 3, line 38), and removing the moldings from the mold (Column 8, lines 3-5). Ono does not show a casting compound containing a surfactant of a specific hardness. Kacher et al., hereafter "Kacher," show that it is known to form moldings from a fluid compound of a material containing a surfactant (Column 4, lines 23-31). Ono and Kacher do not show measuring the hardness of this material as being defined as the force at which an 11mm sphere of the material will shatter, however it is inherent that the material possesses a degree of hardness. The examiner notes that the hardness property in the instant application is found according to an "Erichsen 486" method (Specification, Page 6, line 2). The examiner has not found any indication of hardness testing by this method in the prior art. Ono shows that his material has a breaking strength (Table 1; Column 12, lines 30-35), but it is unclear whether this material property test is related in any way to applicant's method of measuring hardness. Although applicant defines the hardness as the force at which an 11mm sphere of the material will shatter, the examiner has no way of testing or obtaining correlated data by which to determine if Kacher's material meets the claimed hardness range. Therefore, it is the burden of the applicant to prove that the prior art products do not necessarily or inherently possess the hardness of the claimed resin (See MPEP 2112). Kacher and Ono are combinable because they are concerned with a similar technical field, namely, that of molding molding products that are biologically compatible and used for cleaning or grooming purposes. It would

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have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Kacher's surfactant in Ono's molding material in order to give the molded products a cleansing property as well as a beautifying property.

Regarding Claim 2, Ono shows the process as claimed as discussed in the rejection of Claim 1 above, but does not show a material with a solidified hardness of 20 to 120 N, according to applicant's method of determining hardness. It is inherent that any material possesses a degree of hardness. Ono shows that his material has a breaking strength (Table 1; Column 12, lines 30-35), but it is unclear whether this material property test is related in any way to applicant's method of measuring hardness ("Erichsen 486" method (Specification, Page 6, line 2)). Although applicant defines the hardness as the force at which an 11mm sphere of the material will shatter, the examiner has no way of testing or obtaining correlated data by which to determine if Kacher's material meets the claimed hardness range. The examiner has not found any indication of hardness testing by this method in the prior art. Therefore, it is the burden of the applicant to prove that the prior art products do not necessarily or inherently possess the hardness of the claimed resin (See MPEP 2112).

Regarding Claims 5-7, Ono shows the process as claimed as discussed in the rejection of Claim 1 above, including a method (Claim 5) wherein the casting compound is introduced at a single point which is located centrally in the mold (Figure 2 with mold of Figure 4 or Figure 6); (Claim 6) which is an injection molding method (Column 4, lines 46-49); and (Claim 7) wherein the shape corresponding to the moldings is spherical (Column 2, lines 1-2; Column 3, lines 9-13; Column 5, lines 8-11), meeting applicant's claims.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ono and Kacher as applied to claim 1 above, and further in view of Rosato's Injection Molding Handbook (2nd ed.). Ono shows the process as claimed as discussed in the rejection of Claim 1 above, but does not show a mold in which each cavity is arranged closely adjacent to four to six other cavities. Rosato shows that it is known to carry out an injection molding operation wherein each of the cavities, except for cavities in a peripheral position of the mold, is arranged closely adjacent to four to six other of the cavities (Page 239, Figure 4-27). Rosato and Ono are combinable because they are concerned with a similar technical field, namely, that of injection molding operations. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Rosato's mold configuration in Ono's molding operation in order to obtain more articles per injection shot.

Response to Arguments

Applicant's arguments, see Paper No. 8, filed 23 July 2003, with respect to the rejection(s) of claim(s) 1-2 and 4-6 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Ono, Kacher, and Rosato (see above).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the state of the art with regard to molding compositions containing surfactants:

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U.S. Patent 5,206,069 to Borrello

U.S. Patent 6,338,840 to Allan et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica A Fontaine whose telephone number is 703-305-7239.

The examiner can normally be reached on Monday-Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Colaianni can be reached on 703-305-5493. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Maf

Maf
September 25, 2003



MICHAEL COLAIANNI
~~PRIMARY~~ EXAMINER

Supervisory Patent